A K Koh Enterprise Sdn Bhd v A1 Best One Food Industry Sdn Bhd (Pendaftar Cap Dagangan Malaysia, interested party)

HIGH COURT (KUALA LUMPUR) — ORIGINATING SUMMONS NO 24IP-06–03 OF 2013
AZIZAH NAWAWI JC
17 JULY 2014

Trade Marks — Infringement of — Likelihood of deception or confusion — Defendant applied to register trademark resembling plaintiff's prior-registered mark — Registration allowed after registrar held both marks were not same based on one element — Whether registrar should have compared both marks as a whole and not singled out only one item — Whether similarities between marks so great they could deceive/confuse purchasing public into thinking both marks were the same — Whether defendant's mark not registrable under Trade Marks Act 1976 ('TMA') — Whether defendant not 'honest concurrent user' under s 20(1) of the TMA as evidence not shown it had used complete mark prior to date of its application to register the mark

By way of the instant originating summons, the plaintiff sought to set aside a decision of the registrar of Trademarks ('registrar') overruling its objection to, and allowing, an application by the defendant to register a trademark in relation to Bak Kut Teh spices ('the subject mark'). The plaintiff applied for the registration to be set aside contending it had been a manufacturer of, and merchant for, spices and spice preparations for Bak Kut Teh in Malaysia since 1987 and was the prior registered proprietor of a trademark in that respect. The plaintiff asserted that the subject mark was so similar to the plaintiff's mark that it could deceive and confuse the public into thinking the defendant's and the plaintiff's products were the same. The plaintiff said since the subject mark offended various provisions of the Trade Marks Act 1976 ('TMA') the registrar was wrong to have registered it. The defendant alternatively submitted that it was entitled to registration of the subject mark under s 20(1) of the TMA on the ground it had been an 'honest concurrent user' of the 'A1' logo — a feature common to both the plaintiff's and defendant's marks — on its goods for about 13 years.

Held, allowing the application with costs:

(1) The registrar's decision was premised on wrong facts and a misapplication of the law. She compared the two marks by looking merely at one element, namely, the 'A1' logo and deciding that the style of the logo distinguished one mark from the other and was sufficient to indicate the two products came from different sources. The registrar should have

compared the two marks by looking at them as a whole which included the arrangement, layout, get-up, colour scheme and the logo itself to ascertain whether the subject mark was so similar to the plaintiff's mark as to likely confuse and deceive the public into assuming the two marks were connected with each other. In the instant case, the subject mark was likely to confuse or deceive the public contrary to ss 14(1)(a) and 19(1) of the TMA. As such, the subject mark was not registrable and the registrar's decision to register the same was wrong in law (see paras 36, 27, 19 & 28).

(2) Having compared the plaintiff's mark and the subject mark as a whole, the court found the similarities between the two were so astounding as to lead to likelihood of confusion and deception in the minds of the purchasing public. The colour scheme, the layout and the get-up including the position of the 'A1' sign, the location of the white bowl and its contents and the position of Chinese herbs above the bowl in both the marks were so similar it seemed the concept and idea behind both marks was the same. Both marks were used on goods in relation to Bak Kut Teh soup spices and were offered for sale to the public in small packaging at supermarkets, mini markets and sundry shops. The average consumer could have easily mistaken one product for the other and regarded the subject mark as an extension of the plaintiff's registered trademark. This was so whether the two products were placed side by side on the shelves or premised on the doctrine of imperfect recollection (see paras 22–26 & 28–29).

(3) The defendant could not rely on the defence of 'honest concurrent user' under s 20(1) of the TMA as there was no evidence to show it had used the subject mark prior to the date it applied for registration of same. The defendant's reliance on the use of the 'A1' brand for 13 years was irrelevant as the same only constituted a small portion of the subject mark (see para 35).

[Bahasa Malaysia summary

Melalui saman pemula ini, plaintif memohon untuk mengetepikan satu keputusan Pendaftar Cap Dagangan ('pendaftar') yang membatalkan bantahannya kepada, dan membenarkan, satu permohonan oleh defendan untuk mendaftar cap dagang berkaitan dengan rempah Bak Kut Teh ('cap tersebut'). Plaintif memohon agar pendaftaran untuk diketepikan dan menegaskan ia merupakan pengeluar, pedagang untuk, rempah dan persediaan rempah Bak Kut Teh sejak tahun 1987 dan merupakan pemilik berdaftar terdahulu berkaitan dengan cap dagangan itu. Plaintif mengemukakan bahawa cap tersebut menyalahi pelbagai peruntukan Akta Cap Dagangan 1976 ('ACD') dan pendaftar adalah salah untuk mendaftarkannya. Defendan secara alternatif mengemukakan bahawa ia berhak terhadap pendaftaran cap tersebut di bawah s 20(1) ACD atas alasan bahawa ia merupakan 'honest concurrent

user' terhadap logo 'A1' — ciri yang sama bagi kedua-dua cap plaintif dan defendan — pada barangannya selama lebih kurang 13 tahun.

Diputuskan, membenarkan permohonan dengan kos:

(1) Keputusan pendaftar adalah berdasarkan kesilapan fakta dan penyalahgunaan undang-undang. Dia telah membezakan dua cap dengan hanya melihat pada satu elemen, iaitu logo A1 dan memutuskan bahawa gaya logo adalah berlainan daripada yang satu lagi dan adalah mencukupi untuk menunjukkan dua produk itu datang daripada sumber yang berbeza. Pendaftar sepatutnya membezakan kedua-dua cap dengan melihat ianya secara keseluruhan termasuk, pengaturan, layout, get-up, skema warna dan logo itu sendiri untuk menentukan sama ada cap tersebut adalah bersamaan dengan cap plaintif yang mungkin menyebabkan kekeliruan dan memperdayakan pihak awam kepada anggapan dua cap tersebut berkait antara satu dengan lain. Dalam kes ini, cap tersebut adalah berkemungkinan akan mengelirukan dan memperdayakan pihak awam dan bersalahan dengan ss 14(a)(1) dan 19(1) ACD. Oleh itu, cap tersebut tidak boleh didaftarkan dan keputusan untuk mendaftarkannya adalah salah di sisi undang-undang (lihat perenggan 36, 27, 19 & 28).

(2) Setelah membezakan cap plaintif dan cap tersebut secara keseluruhan, mahkamah mendapati persamaan antara keduanya adalah sangat besar yang menyebabkan kepada kemungkinan kekeliruan dan penipuan pada minda pembeli awam. Skema warna, layout dan get-up termasuk kedudukan tanda 'A1', lokasi mangkuk putih dan kandungannya dan posisi herba Cina di atas mangkuk dalam kedua-dua cap adalah begitu sama yang mencadangkan konsep dan idea di belakang kedua-dua cap adalah sama. Kedua-dua cap digunakan untuk barangan berkaitan rempah sup Bak Kut Teh dan ditawarkan untuk dijual kepada pihak awam dalam paket kecil di pasar raya, pasar mini dan kedai runcit. Pengguna biasa dengan mudah sekali akan tersalah satu produk untuk produk yang lain dan menganggap cap tersebut sebagai lanjutan cap dagangan plaintif. Ini adalah begitu sama ada apabila kedua-dua produk itu diletakkan bersebelahan di atas rak atau berdasarkan atas doktrin ingatan yang tidak sempurna (lihat perenggan 22–26 & 28–29).

(3) Defendan tidak boleh bergantung kepada pembelaan 'honest concurrent user' di bawah s 20(1) ACD kerana tiada keterangan untuk menunjukkan ia telah menggunakan cap tersebut sebelum tarikh ia memohon untuk pendaftaran yang sama. Pergantungan defendan terhadap penggunaan jenama 'A1' untuk 13 tahun adalah tidak relevan kerana yang sama hanya merupakan sebahagian kecil cap tersebut (lihat perenggan 35).]]

Notes

For cases on likelihood of deception or confusion, see 12(2) *Mallal's Digest* (4th Ed, 2013 Reissue) paras 2397–2419.

Cases referred to

Elba Group Sdn Bhd v Pendaftar Cap Dagangan dan Paten Malaysia [1998] 4 MLJ 105, HC (refd)

Kuang Pei San Food Products Public Company Limited v Wees Marketing Co Sdn Bhd [2010] MLJU 641; [2012] 2 CLJ 906, HC (refd)

Leo Pharmaceutical Products Ltd A/S (Lovens kemiske Fabrik Produktionsaktieselskab) v Kontra Pharma (M) Sdn Bhd [2009] 5 MLJ 703, HC (refd)

Mem Company Incorporated v Cussons (International) Limited [1974] RPC 7, SC (refd)

Pianotist Co's Application, Re [1906] RPC 774, Ch D (refd)

Sandow Ltd's Application, Re (1914) 31 RPC 196, Ch D (refd)

Shaifubaharim bin Mohd v EM Exhibition (M) Sdn Bhd & Anor [2012] 9 MLJ 84, HC (refd)

Tohtonku Sdn Bhd v Superace (M) Sdn Bhd [1992] 2 MLJ 63, SC (refd)

Yong Teng Hing b/s Hong Kong Trading Co & Anor v Walton International Ltd [2012] 6 MLJ 609; [2012] 6 CLJ 337, FC (refd)

Legislation referred to

Trade Marks Act 1976 ss 10, 10(1)(e), 14(1)(a), 19(1), 20(1) , (1)(a), 25(1), 28(4), 38(1)(a)

Sindy Goh (Wong Kai Fen and Koh Kean Kang with him) (Tan Hee Soon) (Wong & Partners) for the plaintiff.

Kuet Pei Yee (Sri Richgophinath with him) (Skrine) for the defendant.

Azizah Nawawi JC:

THE APPLICATION

[1] The application before this court is an appeal against the decision of the Registrar of Trademarks ('the registrar') dated 18 February 2013 which has allowed the registration of the defendant's trademark application No. 09050016 filed in Class 30 in respect of *Bah Kut Teh Spices (Local Chinese Herbal Soup Ingredients) Being Spices and Condiments; Aromatising or Seasoning Products For Food; Herbs and Spices; Herbs and Mixed Spices; Spice Extracts; Seasoning Mixes; Food Pastes; Prepared Food Mixes; Flavouring For Soups (Other Than Essential Oils)* ('the subject mark').

[2] The decision of the registrar was made under s 28(4) of the Trade Marks Act 1976 ('the TMA 1976') after the plaintiff has filed an opposition against

A the registration of the defendant's said trademark application dated 22 January 2009.

[3] In the originating summons, the plaintiff is seeking to set aside the decision of the registrar dated 18 February 2013 to register the defendant's trademark application and the dismissal of the plaintiff's opposition. The plaintiff also seeks for an order that the defendant's application for registration of its trademark be dismissed.

THE SALIENT FACTS

[4] From the affidavits filed in this case, the plaintiff says that it is a manufacturer and merchant for spices and spice preparation for Bah Kut Teh in Malaysia since 1987, trading under the name and style of Koh Enterprise. The business of Koh Enterprise was transferred to plaintiff, a private limited company incorporated on 21 September 1990.

[5] The plaintiff is the registered proprietor of the trademarks which have been registered in Malaysia on 18 October 2001 for Registration No 0103763 in respect of goods in Class 30 and Registration No 08024789 registered on 17 December 2008.

[6] The defendant is the proprietor of A1 Mountain Globe brand with Registration No 99011923 registered on 24 November 1999 for goods in Class 30 and Registration No 09050013 registered for goods under Class 30.

[7] On 22 January 2009, the defendant applied to register the subject mark in application No 09050016 in Class 30 in respect of Bah Kut Teh Spices.

[8] The defendant's application was advertised on 5 August 2010. During the advertisement process, the plaintiff filed a notice of objection on 17 September 2010. Parties proceeded to file the counter statement and the statutory declarations and written submissions before the registrar.

[9] In the plaintiff's notice of objection, the plaintiff raised three grounds:

(i) that there is a similar registered trademark of the plaintiff on the register being TM No 01013763;

(ii) that there is a similar registered trademark of the plaintiff on the register being TM No 08024789; and

(iii) that there is pending suit before the High Court in Penang initiated by the plaintiff against the defendant for passing off.

[10] On 18 February 2013, the registrar of trademark made a decision to allow the subject mark to proceed towards registration.

[11] Being dissatisfied with the decision of the registrar, the plaintiff filed this appeal against the said decision. In this appeal, the plaintiff is limiting its application to ground (ii) only, which is there is a similar registered trademark of the plaintiff on the register being TM No 08024789.

THE FINDINGS OF THE COURT

[12] The grounds relied by the plaintiff to appeal against the decision of the registrar are as follows:

(i) that the defendant's subject mark is calculated to deceive and cause confusion to the public is therefore not registrable under s 14(1)(a) of the Trade Marks Act 1976 ('the TMA 1976');

(ii) that the defendant's subject mark is confusingly and deceptively similar to the plaintiff's second registered mark and that the defendant's goods are identical or closely related to the goods and services registered under the plaintiff's second registered mark that is offends s 19(1) of the TMA 1976;

(iii) that the defendant's subject mark is not distinctive and it is not registrable under s 10 of the TMA 1976 because of the extensive use of the plaintiff's second registered mark and that the subject mark is confusingly and deceptively similar to the plaintiff's second registered mark; and

(iv) that the defendant cannot lawfully claim to be the proprietor of the subject mark under s 25(1)

(v) of the TMA 1976 because of the extensive use of the plaintiff's second registered mark and that the subject mark is confusingly and deceptively similar to the plaintiff's second registered mark.

Objections premised on ss 14(1)(a) and 19(1)

[13] Section 14(1)(a) of the TMA 1976 provides as follows:

> 14. Prohibition on registration 5
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> (1) A mark or part of a mark shall not be registered as a trademark -
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> (a) If the use of which is likely to deceive or cause confusion to the public or would be contrary to law;

[14] The objective and purpose of s 14(1)(a) is held by the Federal Court in *Yong Teng Hing b/s Hong Kong Trading Co & Anor v Walton International Ltd* [2012] 6 MLJ 609; [2012] 6 CLJ 337 as follows:

A [25] *The objective and purpose of s 14(1)(a) of the Act is to protect the public and consumers from instances of confusion or deception as a result of the use of two similar marks. Thus, under s 14(1)(a) of the Act, a mark shall be refused registration if use thereof is likely to deceive or cause confusion to the public notwithstanding that it is the result of use of an earlier identical or similar mark, whether registered or not in Malaysia and which is being used in relation to good or services which may be different from that sought to be registered.* (Emphasis added.)

[15] The second ground of objection is premised on s 19(1) of the TMA 1976 which reads:

C (1) No trade mark shall be registered in respect of any goods or description of goods —

(a) that is identical with a trade mark belonging to a different proprietor and entered in the Register in respect of the same goods or description of goods ... that are closely related to those goods; or

D (b) that so nearly resembles such a trade mark as is likely to deceive or cause confusion.

[16] It is common ground that the registration of the defendant's subject mark

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H will breach both ss 14(1) and 19(1) of the TMA 1976 if it is deceptively similar to the plaintiffs second registered mark:

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[17] In order to ascertain whether there is likelihood of confusion and deception to the public, the test in the *Re Pianotist Co's Application ('Pianola')* [1906] RPC 774 which referred and approved by our Supreme Court in *Tohtonku Sdn Bhd v Superace (M) Sdn Bhd* [1992] 2 MLJ 63, where the Supreme Court held as follows:

> You must take the two words. You must judge them, both by their look and their sound ... You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those marks are used in a normal way as a trade mark of the goods of the respective owners of the mark.

[18] To ascertain whether there is likelihood of confusion and deception to the public by the use of the subject mark, the comparison must be made as a whole and not merely one element of it. In *Shaifubaharim bin Mohd v EM Exhibition (M) Sdn Bhd* [2012] 9 MLJ 84, the court held as follows:

> the question must be assessed and only answered in its entireties both the plaintiff's mark and the first defendant's disputed mark. Consideration must therefore be given to words and devise as a whole and not merely one element of it. It is not right to take a portion of the trademark in question and compare it with simply another portion of the disputed trademark. The true test is whether the totality of the trademark is such that it is likely to cause deception or confusion.

[19] The registrar's findings on this is as follows:

> As the Applicant's and the Opponent's A1 logos can be distinguished from one another, I think the incorporation of their respective A1 logos into their respective marks is sufficient to indicate that their products come from different sources. As the words 'BAK KUT TEH' and the bowl device which are present in both parties' marks are descriptive and common elements for goods in Class 30, in my view , it

is the 'A1' logos in the respective parties' marks that play an important role in distinguishing between the Opponent's and the Applicant's products. As such, although there are similarities in terms of the use of the use of the words 'BAK KUT TEH'. the bowl device as well as the similar colours in both parties' marks, I am of the view that the presence of the Opponent's and the applicant's A1 logos is sufficient to indicate that the Applicant's and the Opponent's products come from different sources.

[20] It is the submission of the defendant that the essential feature of the subject mark is the defendant's trademark (the A1 in a globe above the mountain) and that the plaintiff's and defendant's 'A1' logos can be distinguished from each other. Therefore, the defendant submits that the incorporation of the respective 'A1' logos into the marks in issue is sufficient to indicate that the products come from different sources.

[21] In addition to that, the defendant submits that since the words 'BAK KUT TEH' and the bowl device present in both marks are descriptive and common elements for goods in Class 30, therefore it is the 'A1' logos in the respective marks that play an important role in distinguishing the products. As such, the defendant submits that the use of the defendant's mark is unlikely to cause confusion or deception to the public under s 14(1)(a) of the TMA 1976.

[22] However, having compared the two marks as a whole, I agree with the submission of the plaintiff that there are many similarities such as the colour scheme used, the layout and the get-up. It would seem that the concept and the idea behind both marks are the same. The two marks, when placed side by side, exhibited many similarities that would cause confusion in the minds of the purchasing public of similar product that such goods are in a way connected to the plaintiff's goods.

[23] I am of the considered opinion that it would seems that the concept and idea behind the subject mark and the plaintiffs second mark is the same, as can be seen from the similarity of the colour scheme, the layout and the get-up, including the location of the bowl and the position of the words 'A1'. In *Mem Company Incorporated v Cussons (International) Limited* [1974] RPC 7, the Supreme Court of Bermuda held that 'IMPERIAL LEATHER' infringes the mark 'ENGLISH LEATHER' because the idea behind the mark is the same.

[24] In *Kuang Pei San Food Products Public Company Limited v Wees Marketing Co Sdn Bhd* [2010] MLJU 641; [2012] 2 CLJ 906, Justice Rhodzariah Bujang dealt with a case on infringement under s 38(1)(a) of the TMA 1976 and made certain findings on the astounding similarity of the colour scheme, the layout and the get-up between the plaintiffs and the defendant's canned sardines that led to confusion to the average consumers of

canned sardines. At pp 914–915, the learned judge said this:

> [13] The plaintiff contended, and I would definitely have to agree, that the defendant's usage of the words 'SMILING BRAND' are deceptively similar to the plaintiff's trade mark even without the pictorial device. What made it even more confusing to the average consumers of canned sardines is the same colour scheme adopted the very same blue tinged fish with a background of a dish of sardines garnished with green vegetables and the pictures of red chillies beneath the fish. What is worst is that the blue fish were depicted on the cans at almost the same angle. Thus, the average consumer could be easily be forgiven if they mistook one for the other; whether these two brands are placed side by side on the supermarket shelves or even if one were to adopt the 'imperfect recollection test' established in *Sandown Ltd's Application* (1914) 31 RPC 196 and explained as follows by Sargant J :
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> > The questions is not whether if a person is looking at two trademarks side by side there would be possibility of confusion; the questions is whether the person who see the proposed trademark in the absence of the other trademark, and in view only of this general recollection of what the nature of the other trademark was, would be liable to be deceived and to think that the trademark before him is the same as the other, of which he has a general recollection.
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> > I did say (though not in identical words) when I granted the interlocutory injunction that what the court should be concerned with in the particular facts of this case is not a consumer who has all the luxury of time to stand at the supermarket's aisle to scrutinize in minute details the get-up of the goods lined on it shelves but an average one, representing the general populace, who would want to make his purchase and leave. The average consumer of canned sardines are not just housewives and restaurant owners, as submitted by the plaintiff's counsels but cuts across almost all levels of society - young and old and I do not agree with counsels' submission that the level of a consumer's intelligence plays a part but rather, whether time is on a consumer's side when making the selection ...
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> [14] It is clear to me when I compared the two get-ups in this case, the colour scheme, the picture of the blue fish, the angle of its depiction, the vegetable dish behind it and the chillies at the bottom of the tin, the similarities between them are simply astounding. When I throw in the word 'Smiling' into the whole assemble I cannot but draw the conclusion that there is trademark infringement by the defendant. (Emphasis added.)

[25] The similarities between the plaintiff's second registered mark and the defendant's subject mark can be seen from the followings:

1.	Outer Frame	Both have mixture red and brown colour frame
2.	Inner Frame (outline)	Both have yellow colour inner frame (outline)
3.	Background colour	Both background are pink colour
4.	Brand	Both contain A1 which is placed on top left corner of the mark

5.	A1	Both A1 are red colour
6.	White Bowl	Both marks have one (1) white bowl which is placed at the bottom right corner of the mark
7.	Soup	Both marks contain soup in the bowl
8.	Meat bone	Both marks contain some meat bone in the bowl
9.	Garlic	Both marks contain one big garlic in the bowl
10.	Chinese herb	Both marks contain Chinese herbs above the bowl

[26] Comparing the two products, I am of the considered opinion that from the same colour scheme used, the position of the A1 (both red in colour), the location of the white bowl, which contain soup of meat bones and garlic, and position the Chinese herbs above the bowl, the similarities between them are simply astounding that would lead to likelihood of confusion and deception.

[27] Premised on the reasons above, I am of the considered opinion that the registrar has erred in law and in fact when looking merely looking at one element when making the comparison, which is the A1 logo. The registrar should have made the comparison by looking at the mark as a whole, which includes the arrangement, the layout, the get-up, the colour scheme and the logo in order to ascertain whether the defendant's subject mark is similar to the plaintiff's second mark, thereby causing a likelihood of confusion and deception to the public.

[28] Further, where the products are similar or closely related, there is a higher likelihood of confusion and deception that members of the public would assume that the two marks are connected with each other. Both marks are used on goods in relation to Bah Kut Teh soup spices and are sold to the public in small packaging at supermarkets, mini markets and sundry shops. Consumers of this product are mostly housewives who purchased such 'ready to mix' soup spices for cooking purposes. Most of these housewives will not make a detailed examination of the two labels before purchasing the product. As such, both marks share the same trade channels and target the same customers. In *Leo Pharmaceutical Products Ltd A/S (Lovens kemiske Fabrik Produktionsaktieselskab) v Kontra Pharma (M) Sdn Bhd* [2009] 5 MLJ 703, the court held that:

> Where the parties' goods or service are in direct competition with each other, only a small degree of similarity is required to establish the likelihood of confusion.

[29] Due to the similarity of the two products, the average consumer could have easily mistaken one for the other, or that the public will regard the subject mark as an extension of the plaintiff's registered trademarks. This is so whether these two products are placed side by side on the shelves or premised on the

doctrine of imperfect recollection established in *Re Sandow Ltd's Application* (1914) 31 RPC 196, which sets out the following principle:

> The questions is not whether if a person is looking at two trademarks side by side there would be possibility of confusion; the questions is whether the person who see the proposed trademark in the absence of the other trademark, and in view only of this general recollection of what the nature of the other trademark was, would be liable to be deceived and to think that the trademark before him is the same as the other, of which he has a general recollection.

[30] Therefore, I am of the considered opinion that the registrar has made an error when she found that the plaintiff's and the defendant's 'A1' logos can be distinguish from each other. If the letter 'A' and the number '1' has been disclaimed, the same cannot be considered to be the essential element and the distinguishing factor. Looking at the products as a whole, it cannot be denied that the essential elements, which are the layout, the arrangement and the colour scheme, are distinctively similar. The registrar has erred in law and in fact when she allowed the subject mark to proceed towards registration as its registration contravenes ss 14(1)(a) and 19(1) of the TMA 1976.

Issue on concurrent use

[31] Alternatively, it is the submission of the defendant that they are entitled to registration of the subject mark pursuant to s 20(1)(a) of the TMA 1976, which reads:

> 20 Concurrent use
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> (1) Notwithstanding subsection 19(1), in the case of honest concurrent user ... the Court or the Registrar may permit the registration of more than one proprietor in respect of trademarks which are identical or so resembling each other as are likely to deceive or cause confusion where the registration of the different proprietors -
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> (a) is in respect of the same goods or description of goods; or
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> (b) in the case of at least one proprietor, is in respect of goods, and in the case of the other or others, is in respect of services closely related to those goods,
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> Subject to such conditions, amendments, modifications or limitations, if any, as the Court or the Registrar, as the case may be, may think right to impose.

[32] The defendant submits that it has extensively and continuously adopted and used the A1 brand marks in the sales of the defendant's goods for about thirteen years, and is therefore entitled to register the subject mark under s 20(1) of the TMA 1976.

[33] In *Elba Group Sdn Bhd v Pendaftar Cap Dagangan dan Paten Malaysia* [1998] 4 MLJ 105, the issue of honest concurrent user under s 20(1) of the

TMA 1976 was raised. At p 112, the court held that:

> However, on perusal of the affidavits of the appellant, I find that there is no definite evidence of period of time of use of the trademark 'adax' by the appellant prior to the date of application for registration to justify 'honest concurrent user'. In order to support the claim of 'honest concurrent user' under s 20(1), a party must prove honesty of user and the period of time of use of the trademark by the party prior to the date of application for registration (see Tiga Gajah). Since the evidence of the period of time is lacking, the appellant is therefore not protected by the doctrine of 'honest concurrent user'. (emphasis added)

[34] It is not in dispute that the date for application of registration of the defendant's subject mark is 22 January 2009. So, the issue here is whether there is any evidence of use of the subject mark by the defendant before 22 January 2009, in order to attract the protection of s 20(1) of the TMA 1976.

[35] Having considered the affidavits, I agree with the plaintiff that there is no evidence to show the use of the subject mark by the defendant prior to the registration date of 22 January 2009. The defendant's reliance on the use of the

for 13 years is not relevant, as the same only constitutes a small portion of the subject mark. As such, the defendant cannot rely on the defence of 'honest concurrent use' under s 20(1) of the TMA 1976.

CONCLUSION

[36] In the premise, I am of the considered opinion that the decision of the registrar is premised on wrong facts and based on a misapplication of the law. The use of the subject mark by the defendant is likely to cause confusion or deception to the public contrary to s 14(1)(a) and s 19(1) of the TMA 1976. As such, the defendant's trademark application No 09050016 is not registrable and the registrar's decision to register the same is erroneous in law. In the premise, the plaintiff's appeal is allowed and the originating summons is allowed with costs.

[37] As I have allowed the appeal premised on ss 14(1)(a) and 19(1) of the TMA 1976, there is no necessity for me to consider the objections premised on ss 25(1) and 10(1)(e) of the TMA 1976.

Application allowed with costs.

Reported by Ashok Kumar